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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/629,163      | 07/29/2003  | James M. Costley     | 25.0196             | 5986             |

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EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT PAPER NUMBER

3672

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/629,163

Applicant(s)

COSTLEY ET AL.

Examiner

Jennifer H. Gay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 and 7-28 is/are allowed.
- 6) ☒ Claim(s) 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/29/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 161, 205, and 207. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The disclosure is objected to because of the use of the phrase "Out/In straddle tool". This is not a term that is familiar to the art as the examiner was not been able to find a similar term in the prior art. While the meaning of the term can be ascertained by the reading of the specification relative to the figures, the term on its face is unclear. The examiner understands that applicant has the right to be his own lexicographer thus it is merely suggested that the above term be changed to one more familiar to the art.

Appropriate correction is required.

### ***Claim Objections***

3. Claims 1-4, 6, 8-10, 13-17, 19-21, 25-28 are objected to because of the following informalities:

- Claims 1-4, 6, 8, and 25-28 are objected to because of the use of the phrase "Out/In straddle tool". This is not a term that is familiar to the art as the examiner was not been able to find a similar term in the prior art. While the

meaning of the term can be ascertained by the reading of the specification relative to the figures, the term on its face is unclear and the claims must be understood without the specification. It is suggested that the above phrase be changed to one more familiar in the art.

- Claims 1, 3, 4, 6, 8, 13-17, 19-21, 25, and 26 are objected to because it is suggest that “Out port” be changed to --outlet port--, “In port” be changed to -inlet port--, and “Out mandrel” be changed to --outlet mandrel--.
- Claims 2 and 8 are objected to because the phrase “in the event...” can be understood to synonymous with such phrases as “may be” or “if” and therefore it is unclear if applicant considers the limitation that follows to be pertinent, i.e. it is unclear if the limitation is positively claimed.
- Claims 3, 4, 10, 15, and 17 are objected to because of the use of the term “gentle bends”. It is not possible for the examiner or one of ordinary skill in the art to determine what applicant considers a “gentle” bend.
- Claims 6, 9, 16, and 26 are objected to because of the use of the term “sufficiently”. It is not possible for the examiner or one of ordinary skill in the art to determine what applicant considers the term “sufficiently” to cover.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is considered indefinite because it is recited that the “Out/In straddle tool” “integrates” features which claim 1 has already recited the tool as having, i.e. the “Out and In ports” and “packer mounting” (the examiner notes that claim 1 does not specifically include the term “packer mounting” however the packer elements must be

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secured to the tool in some fashion). It is unclear what applicant is trying to indicate by stating that these features are integrated in the tool. Clarification and correction are required.

***Allowable Subject Matter***

6. Claims 1-5 and 7-28 are allowed.

***Conclusion***

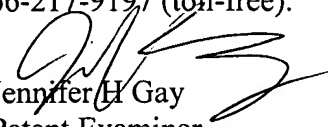
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


The remaining references made of record disclose various wellbore cleaning tools, fracturing tools, and gravel packing tools.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H. Gay whose telephone number is (571) 272-7029. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jennifer H. Gay  
Patent Examiner  
Art Unit 3672

JHG   
June 9, 2005